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Paper No. 11

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MAILED

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Technology Center 2100

In re Application of: Ono)
Application No. 09/873,649)
Attorney Docket No. A3156.0022/PO22) **DECISION ON PETITION TO**
Filed: June 4, 2001) **WITHDRAW HOLDING OF**
For: INTEGRATED CIRCUIT FOR) **ABANDONMENT UNDER 37 CFR**
MODEM) **\$1.181**

This is a decision on the request for reconsideration filed August 5, 2004 by Mr. Steven I. Weisburd requesting the Withdrawal of the Holding of Abandonment of the above-identified application. The original petition, filed April 9, 2004, was dismissed July 7, 2004. This application was held abandoned for failure to respond to the Office action mailed September 23, 2003 (Paper No. 3). A Notice of Abandonment was mailed on March 31, 2004 (Paper No. 4).

Applicable Prosecution History

September 23, 2003 FAOM mailed to Ostrolenk Faber Gerb & Soffen (Paper no. 3)
March 31, 2004 Notice of Abandonment mailed
April 9, 2004 Petition to withdraw abandonment filed
May 28, 2004 Change of address submitted for Dickstein et al.
October 28, 2004 Revocation of power of attorney filed

Evidence in Support of Original Petition

In the original petition, Mr. Weisburd provided a declaration that the Office action was not received; that the practitioner filed a change of address "on or about February 6, 2002"; and that the practitioner became aware of the Office action when the examiner contacted the practitioner (date not specified). The petition further contained a statement from the practitioner that a search of the file jacket and the docket records indicates the Office action was not received. A copy of the Dickstein docket record was included.

The petition stated Mr. Weisburd transferred his practice from Ostrolenk Faber Gerb & Soffen, LLP (hereinafter "Ostrolenk") to the firm of Dickstein Shapiro Morin & Oshinsky, LLP (hereinafter "Dickstein") on January 2, 2002. The original petition stated that subsequent to the change in firms, an employee of Dickstein, Mr. David Andres, picked up mail received for Mr.

4) a reference to the docket record in the practitioner's statement.

The request remains defective. In the latest submission, the declaration by Mr. Moskowitz and the accompanying docket records fail to encompass the time period around the period of the mailing of the Office action. Specifically, the "true copy of said docket records" from Ostrolenk appear to span the period of 01 June 2001 to 10 January 2002. As Mr. Weisburd has already stated in the previous petition that he joined Dickstein in January 2002, it is not surprising that the records of Ostrolenk would not reflect any communications after January 2002. The evidence submitted to date still has not overcome the presumption of receipt.

There remains the issue of the involvement of Morgan Stanley Mail Services because of the markings on the envelope. Mr. Moskowitz can only make the statement that "[t]o the best of my knowledge and belief, Morgan Stanley Mail Services has not had any operations at 1180 Avenue of the Americas during the period from January 1, 2002 to the current date." This statement does not reflect any knowledge other than that of a managing partner of Ostrolenk. It does not serve to establish anything other than what was in the personal knowledge of one person with no particular expertise in matters of mail delivery in an office complex in New York City.

Finally, there is the matter of Mr. Weisburd's failure to promptly notify the Office of his new correspondence address. All of the statements and evidence provided point to the fact that no address change was submitted until May 28, 2004, two and a half years after Mr. Weisburd departed Ostrolenk. Mr. Weisburd stated in the original petition that "[a]ny mail received for Mr. Weisburd at Ostrolenk was picked up by an employee of Dickstein and brought to the Dickstein docketing department" (see page 3 of original petition). Mr. Weisburd states that Ostrolenk "has not moved."

The resulting returned mail appears to have occurred because of factors involving mail delivery problems created either by the practitioner (for failure to properly and timely file a change of address request) or by persons other than employees of the US Postal Service. Therefore, the record submitted is not adequately probative of non-receipt. It is just as equally supportive of the likelihood of the Office communication going astray after receipt at the correspondence address of record.

The petition is **DENIED**.

The petitioner may wish to consider filing a petition to revive under 37 CFR § 1.137. Telephone inquiries should be directed to the Pinchus Laufer at (571) 272-3599.



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